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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,395	02/05/2004	Dominique Bergeron	Q-79408	4148

23373 7590 09/28/2006  
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WASHINGTON, DC 20037

EXAMINER

FORD, VANESSA L

ART UNIT PAPER NUMBER

1645

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/771,395	<b>Applicant(s)</b> BERGERON ET AL.	
	<b>Examiner</b> Vanessa L. Ford	<b>Art Unit</b> 1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**Election/Restriction**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3 are drawn to a method for inhibiting bacterial growth comprising contacting a bacterium with an antibacterial compound that specifically binds to a bacteriophage polypeptide binding domain classified in class 435, subclass 5. Further species election required.
- II. Claims 4-14 are drawn to an isolated polypeptide and antibacterial compound, classified in class 530, subclass 300. Further species election required.
- III. Claims 15-25 are drawn to a screening method, classified in class 435, subclass 4. Further species election required.
- IV. Claims 26-30 are drawn to an isolated or purified polynucleotide and nucleic acid classified in class 536, subclass 23.1.
- V. Claims 31-35 are drawn to an antibacterial compound, classified in class 530, subclass 300. Further species election required.

2. Groups I and (II, IV and V) are related as method of using and product used.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a material

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different process (MPEP 806.05(h)). In the instant case, the isolated polypeptide of Group II can be used to make antibodies.

3. Groups I and III are different methods. They differ because they have different goals, require different method steps and parameters.

4. Groups II and III are related as product and method of using. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a material different process (MPEP 806.05(h)). In the instant case, the isolated polypeptide of Group II can be used to make antibodies.

5. Groups II, IV and V are drawn to different products. These products differ structurally.

6. Groups III and (IV and V) are unrelated as method of using and product used. The products of Group IV and V are not required for the methods of Group III.

7. In the event that applicant elects Group I, claims 1-3, applicant is required to elect a single sequence to be examined in the application with the elected invention. Claims 1-3 are generic to a plurality of disclosed patentably distinct species, based on structural and functional differences.

Species a) SEQ ID NO:3

Species b) SEQ ID NO:4

Species c) SEQ ID NO:5

Species d) SEQ ID NO:7

Species e) SEQ ID NO:8

8. In the event that applicant elects Group II, claims 4-14, applicant is required to elect a single sequence to be examined in the application with the elected invention. Claims are generic to a plurality of disclosed patentably distinct species, based on structural and functional differences.

Species a) SEQ ID NO:2

Species b) SEQ ID NO:3

Species c) SEQ ID NO:4

Species d) SEQ ID NO:5

Species e) SEQ ID NO:7

Species f) SEQ ID NO:8

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9. In the event that applicant elects Group III, claims 15-25, applicant is required to elect a single sequence to be examined in the application with the elected invention.

Claims are generic to a plurality of disclosed patentably distinct species, based on structural and functional differences.

Species a) SEQ ID NO:3

Species b) SEQ ID NO:4

Species c) SEQ ID NO:5

Species d) SEQ ID NO:7

Species e) SEQ ID NO:8

10. In the event that applicant elects Group V, claims 31-35, applicant is required to elect a single sequence to be examined in the application with the elected invention.

Claims are generic to a plurality of disclosed patentably distinct species, based on structural and functional differences.

Species a) SEQ ID NO:3

Species b) SEQ ID NO:4

Species c) SEQ ID NO:5

Species d) SEQ ID NO:7

Species e) SEQ ID NO:8

11. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

12. Because these inventions are distinct for the reasons given and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification, restriction for examination purposes as indicated is proper. Moreover, in the absence of restriction it would place an undue search and examination burden on the examiner.

13. Applicant is advised that the reply to this requirement to be complete must include an election of invention to be examined even though the requirement be traversed (37 CFR 1.143).

14. Applicant is reminded that upon that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

15. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims



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and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

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
### ***Conclusion***

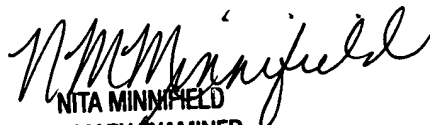
16. Any inquiry of the general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Office Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for the Group 1600 is (571) 272-8300.

Any inquiry concerning this communication from the examiner should be directed to Vanessa L. Ford, whose telephone number is (571) 272-0857. The examiner can normally be reached on Monday – Friday from 9:00 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Albert Navarro, can be reached at (571) 272-0861.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov./>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Vanessa L. Ford  
Biotechnology Patent Examiner  
September 21, 2006

  
NITA MINNIFIELD  
PRIMARY EXAMINER